

Customer No. 22,852
Attorney Docket No. 3626.0034-05

II. Rejection Under § 112, first paragraph

The Examiner rejected claims 1, 4-8, 13, 14, and 18-32 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Office Action at page 2. Specifically, the Examiner asserts that the specification is nonenabling because it "does not describe how to make a fabric having a powdered coating on at least a portion of the fabric surface, wherein the entire coating is 'powdered'" *Id.* Applicants respectfully traverse this rejection for at least the reasons set forth below.

The Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. M.P.E.P. § 2164.04 (citing *In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993)). The M.P.E.P., citing Federal Circuit law, is very specific with regard to the procedures Examiners must follow in order to establish whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement. See M.P.E.P. § 2164.01(a). A number of factors, known as the Wands factors, must be considered when making such a determination. *Id.* (citing *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988)). These factors include:

- (1) the breadth of the claims;
- (2) the nature of the invention;
- (3) the state of the prior art;
- (4) the level of one of ordinary skill;
- (5) the level of predictability in the art;
- (6) the amount of direction provided by the inventor;
- (7) the existence of working examples; and
- (8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure.

Id.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Customer No. 22,852
Attorney Docket No. 3626.0034-05

In valuating these *Wands* factors, the M.P.E.P. requires the Examiner to consider all the evidence related to each one of these factors, and any conclusion of enablement must be based on the evidence as a whole. *Id.* Applicants respectfully submit that the Examiner has not addressed a single one of these factors in this case and, therefore, has failed to meet her burden.

Moreover, Applicants submit that an evaluation of these *Wands* factors, particularly the present disclosure and the knowledge of one skilled in the art, will lead to the conclusion that the specification enables a fabric comprising a powdered coating composition on at least a portion of a surface of the fabric. Accordingly, Applicants respectfully request that this ground of rejection be withdrawn.

III. Rejections Under 35 U.S.C. § 103

A. *Sakaguchi et al.* in view of *Raghupathi et al.*

The Examiner has rejected claims 1, 4-8, and 18-30 under 35 U.S.C. § 103(a) as being unpatentable over *Sakaguchi et al.* (U.S. Patent No. 4,006,272) ("*Sakaguchi*") in view of *Raghupathi et al.* (U.S. Patent No. 6,139,958) ("*Raghupathi*") for the reasons disclosed on page 3 of the Office Action. Applicants traverse this rejection for at least the following reasons.

Applicants respectfully submit that Applicants' invention is not obvious over *Sakaguchi* in view of *Raghupathi* because the Examiner has failed to satisfy the initial burden of proof for setting forth a prima facie case of obviousness. To establish a prima facie case of obviousness the Examiner must demonstrate that (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP
1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Customer No. 22,852
Attorney Dock t No. 3626.0034-05

combin the reference teachings, and (2) the prior art reference or references teach all the claim limitations. M.P.E.P. § 2142. Here, the Examiner has not established either of these listed requirements.

The Examiner has not established that Sakaguchi teaches or suggests "a plurality of *discrete particles*" as recited in claim 1 of the present invention. The Examiner has also made no assertion that this claim limitation is inherent in the prior art, and Applicants respectfully submit that the Examiner can not do so. Sakaguchi teaches a powder of unsaturated polyester resin scattered on glass fibers and then placing the fibers in an oven such that the resin is *melted* and functions to bind the glass fibers to one another. See Sakaguchi at col.1, lines 15-19. This binder does not read on the claim element "discrete" as defined in the disclosure of the present invention which requires "that the particles *do not tend to coalesce or combine to form continuous films* under conventional processing conditions, but instead substantially retain their individual distinctness, and generally *retain their individual shape or form*. Specification at page 12, lines 14 -17. Raghupathi does not cure this deficiency in that its disclosure makes no mention of discrete particles.

Moreover, the Examiner has not shown, nor do the references contain, the motivation to combine the two disparate compositions. The Examiner has a high burden to set forth a prima facie case of obviousness. Federal Circuit caselaw holds that "[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence in the record. The precedent has been reinforced in myriad decisions, and cannot be dispensed with." *In re Lee*, 277 F.2d 1338, 1343 (Fed. Cir. 2002).

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Customer No. 22,852
Attorney Docket No. 3626.0034-05

Here, the Examiner has not presented objective evidence to support her subjective, unsupported assertion of obviousness. In fact, without further explanation, the Examiner's only statement regarding motivation in the rejection pertains to the glass fibers of claims 6-8 and states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use as the glass fibers of Sakaguchi, any glass fibers known in the art, such as those taught by Raghupathi and contemplated by applicants, with the reasonable expectation of success of obtaining a glass fiber mat having great transparency.

Office Action at page 4. As described above, the Federal Circuit has rejected Examiners' attempts to use such general, non-specific and perfunctory statements to establish a case of prima facie obviousness. See *Lee*, 277 F.3d at 1338.

Furthermore, simply because Raghupathi teaches glass fibers is not sufficient to show a motivation to choose Raghupathi to modify Sakaguchi considering the myriad of references in the glass fiber art. Applicants submit that the Examiner's proposed combination fails to take into account the disparate teachings of the references: Sakaguchi teaches a resin used to bind glass fibers together, while the chemical treating composition of Raghupathi is applied to glass fibers for the purposes of controlling wettability and weatherability. Accordingly, Applicants request that this ground of rejection be withdrawn. The rejection of the claims 4-8 and 18-30 should be withdrawn for at least their dependency to claim 1.

Additionally, Applicants would like to specifically address the Examiner's improper rejection of dependent claims 20, 21, 23, 24, 29, and 30, directed to weight percentage limitations of the plurality of discrete particles, the at least one lubricious material, and the at least one film-forming material, in which the Examiner alleges that

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Cust mer No. 22,852
Attorney Docket No. 3626.0034-05

"when the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." Office Action at page 3. Applicants respectfully submit that the Examiner has misapplied the law. Although it is not inventive to discover the optimum or workable ranges by routine experimentation where the general conditions of a claim are disclosed in the prior art, a "particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." M.P.E.P. § 2144.05 II. at 2100-138 (citing *In re Antoine*, 559 F.2d 618 (CCPA 1977)). Here, the Examiner has provided no evidence that the plurality of discrete particles, the at least one lubricious material, or the at least one film-forming material of the present invention is recognized to be "result-effective." Accordingly, Applicants request that this rejection be withdrawn.

B. Kotera et al. in view of Raghupathi et al.

The Examiner has rejected claims 1, 4-8, 13, 14, and 18-32 under 35 U.S.C. § 103(a) as being unpatentable over Kotera et al. (U.S. Patent No. 4,340, 519) ("Kotera") in view of Raghupathi et al. (U.S. Patent No. 6,139,958) ("Raghupathi") as applied to claims 1, 4-8, and 18-30, for the reasons disclosed on page 4 and 5 of the Office Action. Applicants traverse this rejection for at least the following reasons.

As above, Applicants respectfully submit that Applicants' invention is not obvious over Kotera in view of Raghupathi because the Examiner has not established that (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP
1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Customer No. 22,852
Attorney Docket No. 3626.0034-05

reference or to combine the reference teachings, and (2) the prior art reference or references teach all the claim limitations.

The Examiner has not shown that Kotera, expressly or inherently, teaches "a plurality of *discrete* particles" as recited in claim 1 of the present invention and, as explained in Section III. A. above, Raghupathi can not cure this deficiency. Moreover, the Examiner has not properly shown, nor do the references contain, the motivation to combine the two compositions. The Examiner's only statement regarding motivation in the rejection pertains to the glass fibers of claims 6-8 and states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Kotera by using as the glass substrate, a glass cloth or mat as taught by Raghupathi, wherein the specific glass used is any fiberizable glass material known to the art, such as those contemplated by applicants and as taught by Raghupathi with the reasonable expectation of success of forming glass products having excellent transparency.

Office Action at page 5. As explained above in section III. A., examiners' attempts to use such general, non-specific and perfunctory statements cannot establish a prima facie case of obviousness. With regard to the glass fibers, the Examiner has again proffered no evidence why one skilled in the art would choose the glass fibers of Raghupathi from the multitude of glass fibers available in the technology. Thus, there is no motivation to combine the teachings of Kotera and Raghupathi as suggested by the Examiner. Accordingly, Applicants request the withdrawal of this ground of rejection. The rejection of the claims 4-8, 13, 14, and 18-32 should be withdrawn for at least their dependency to claim 1.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax: 202.408.4400
www.finnegan.com

Custom r No. 22,852
Attorney D cket No. 3626.0034-05

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 27, 2004

652020_1.DOC

By: 

Mark D. Sweet
Reg No. 41,469

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com